

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 814072335 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 29, 2009

Signature: 

(Diane Blewins)

Patent

Docket No. 532212000623

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES
FOR DETECTING PARATHYROID
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

Confirmation No. 4476

**SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER MPEP § 724.02**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the duty of disclosure in 37 C.F.R. § 1.56, Applicants hereby submit under MPEP § 724.02 the document listed on the attached Form PTO/SB/08a/b. The attention of the Patent and Trademark Office is hereby directed to this document because it is **SUBJECT TO PROTECTIVE ORDER**. It is respectfully requested that the Examiner consider the information during the prosecution of this application.

The document listed on the attached Form PTO/SB/08a/b is **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of the document that is

sd-495312

EXHIBIT "A"

SUBJECT TO PROTECTIVE ORDER listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

The document is from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, at the United States Court of Appeals for the Federal Circuit, Case No. 2009-1481. This litigation involves U.S. Patent No. 6,689,566. The present application is a Continuation-in-Part of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Scantibodies Laboratory, Inc. is the assignee of the present application.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☒ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of ___ is enclosed.
 - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of ___ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.)

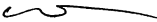
Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 532212000623.

Dated: October 29, 2009

Respectfully submitted,

By 
Peng Chen
Registration No.: 43,543
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858) 720-5117



ALTERNATIVE TO PTO/SB/08A/B
(Based on PTO 08-08 version)

INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>			Complete if Known		
			Application Number	10/617,489	
			Filing Date	July 10, 2003	
			First Named Inventor	Thomas L. CANTOR	
			Art Unit	1641	
			Examiner Name	C. Cheu	
			Attorney Docket Number	532212000623	
Sheet	1	of	1		

NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER			
Examiner Initials	Cite No.¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	2
	1.	Confidential Brief of Plaintiff-Appellant Scantibodies Laboratory, Inc., filed October 26, 2009, United States Court of Appeals for the Federal Circuit, Case No. 2009-1481	

Examiner Signature		Date Considered	
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¹EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

²Applicant's unique citation designation number (optional). ³Applicant is to place a check mark here if English language Translation is attached.

11/2/09

1/2/09

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airmail No. EV 814072335 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

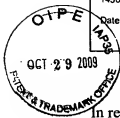
Dated: October 29, 2009

Signature:

(Diane Blevins)

Patent

Docket No. 532212000623



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES
FOR DETECTING PARATHYROID
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

Confirmation No.: 4476

**PETITION TO EXPUNGE INFORMATION
UNDER 37 C.F.R. § 1.59 (b)**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants hereby petition the Commissioner to have the document submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on October 29, 2009 expunged upon allowance, issue, or abandonment of this application.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for the document listed on the attached Form PTO/SB/08a/b because it is **SUBJECT TO PROTECTIVE ORDER**. The document is from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, Case No. 2009-1481 at the United States Court of Appeals for Federal Circuit.

This document has not otherwise been made public.

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sd-495341

Applicants acknowledge that upon the grant of this petition and return of the document that is **SUBJECT TO PROTECTIVE ORDER**, Applicants will preserve the document for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the document to the undersigned upon allowance, issue, or abandonment of this application.

Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

Pursuant to MPEP § 725.05 (E), the Commissioner is hereby authorized to charge the required fee under 37 C.F.R. § 1.17(g) for a petition under 37 C.F.R. § 1.59(b) to **Deposit Account No. 03-1952** referencing docket no. 532212000623. Fee Transmittal (form PTO/SB/17p) is attached in duplicate.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000623.

Dated: October 29, 2009

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP

12531 High Bluff Drive, Suite 100

San Diego, California 92130-2040

(858)720-5117



PETITION FEE
Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/617,489
Filing Date	July 10, 2003
First Named Inventor	Thomas L. CANTOR
Art Unit	1641
Examiner Name	C. Cheu
Attorney Docket Number	53221200623

Enclosed is a petition filed under 37 CFR 1.159 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(f), see form PTO/SB/17f.

Payment of Fees (small entity amounts are NOT available for the petition fees).

☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :
☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments

☐ Check in the amount of \$ _____ is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.36(a) – for revocation of a power of attorney by fewer than all applicants
- § 1.53(a) – to accord a filing date.
- § 1.57(a) – to accord a filing date.
- § 1.182 – for decision on a question not specifically provided for.
- § 1.183 – to suspend the rules.
- § 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 – for access to an assignment record.
- § 1.14 – for access to an application.
- § 1.47 – for filing by other than all the inventors or a person not the inventor.
- § 1.59 – for expurgement of information.
- § 1.103(a) – to suspend action in an application.
- § 1.138(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 – for review of refusal to publish a statutory invention registration.
- § 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) – for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.959 – for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 – for expedited handling of a foreign filing license.
- § 5.15 – for changing the scope of a license.
- § 5.25 – for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) – to request documents in a form other than that provided in this part.
- § 1.84 – for accepting color drawings or photographs.
- § 1.91 – for entry of a model or exhibit.
- § 1.102(d) – to make an application special.
- § 1.138(c) – to expressly abandon an application to avoid publication.
- § 1.312 – to withdraw an application from issue.
- § 1.314 – to defer issuance of a patent.

Signature

Peng Chen

Typed or printed name

Date

October 29, 2009

43,543

Registration No., if applicable



PTO/SB/21 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission	9	Application Number	10/617,489
		Filing Date	July 10, 2003
		First Named Inventor	Thomas L. CANTOR
		Art Unit	1641
		Examiner Name	C. Cheu
	Attorney Docket Number	532212000623	

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form (Petition Fee Under 37 CFR 1.17(g) - 1 page) <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement (Supplemental - 3 pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition to Expunge Information (2 pages) <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): PTO/SB/08A/B (1 page, plus duplicate) 1 reference - placed in separate envelope appropriately labeled Return Receipt Postcard
Remarks CUSTOMER NO. 25225		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Peng Chen		
Date	October 29, 2009	Reg. No.	43,543

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MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 29, 2009

Signature:

(Diane Blevins)



UNITED STATES PATENT AND TRADEMARK OFFICE

NOV 05 2009

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1460
Alexandria, VA 22313-1460
www.uspto.gov

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

In re Application of :
Cantor et al. : PETITION DECISION
Serial No.: 10/617,489 :
Filed: July 10, 2003 :
Attorney Docket No.: 532212000623 :

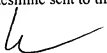
This is in response to the petition under 37 CFR § 1.59(b), filed October 29, 2009, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the documents submitted with the Supplemental Information Disclosure Statement filed on October 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

This is an examined application. As such the information provided has been reviewed, in part, but proceedings in the application have not been terminated. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. The information cannot be expunged at this time.

The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte* Quayle action being mailed in the application. No additional petition fee will be required at that time.

Should there be any questions about this decision please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.


Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600